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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,154	07/03/2003	Anna-Carin Elfstrom	018798-171	4120

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BURNS, DOANE, SWECKER & MATHIS, L.L.P.
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Alexandria, VA 22313-1404

EXAMINER

HAND, MELANIE JO

ART UNIT	PAPER NUMBER
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3761

MAIL DATE	DELIVERY MODE
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09/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/612,154

Applicant(s)

ELFSTROM ET AL.

Examiner

Melanie J. Hand

Art Unit

3761

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

TATYANA ZALUKAEVA
PRIMARY EXAMINER

Continuation of 3. NOTE: New claim 36 requires a new search and consideration after a final action has been mailed.

Continuation of 11. does NOT place the application in condition for allowance because: As to applicant's arguments in the Lack of Completeness of Office action section: Applicant argues that the Office has not met applicant's request for a citation from Rooyakkers that supports the Office's rejection of claim 1. That citation is Col. 5, lines 10-22 of Rooyakkers.

As to applicant's arguments regarding the rejection of claims 1, 2, 6-14, 16-20, 23-28 and 34-36: Applicant argues that there is nothing in the Rooyakkers disclosure to support the Office's position that the liquid permeable and liquid -impermeable layers are sealed together beyond the edge of the absorbent layer. The passages in Rooyakkers that support this position are Col. 3, lines 38-42 and Col. 6, lines 62-64. Applicant cites Col. 3, lines 39-42 but fails to acknowledge that the passage distinctly describes an impermeable material to which absorbent is adhered, and the resulting structure is then attached to the permeable layer, thus the impermeable layer is attached to the permeable layer. The citation of Col. 6, lines 62-64 further distinctly show that the attachment is at the edges that are necessarily beyond the absorbent, otherwise the two layers could not be sealed to each other at their edges because the absorbent therebetween would prevent that.

As to applicant's argument that Rooyakkers does not teach a discrete shaped absorbent body in a sheath that tapers into a narrower crotch portion, applicant appears to be combining two embodiments. The folded sheet embodiment is separate from the sheath embodiment. In Col. 6, lines 38-41, Rooyakkers teaches that the pouch (which includes the absorbent that extends to a point near the edges of the permeable and impermeable layers) tapers to a narrower point toward the crotch, i.e. slightly below the penis of the user as claimed.

As to applicant's arguments regarding the placement of the liquid barrier, it has been clearly and repeatedly stated in the rejection to claim 1 in previous Office actions that Li provides the desired placement of the liquid barrier. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to applicant's arguments regarding the combination of Rooyakkers and Li, again, applicant is attacking the references individually. Li need not teach any of the limitations of claim 1 that have already been taught by Rooyakkers. The Office has already explained that Li is reasonably pertinent art and since the devices of Rooyakkers and Li are both concerned with urinary incontinence, the combination of references is valid. The Office maintains the position that it is immaterial what portion of the bodily fluid exit path each device is concerned with and it is immaterial what gender each device is concerned. The fact that the absorbent material "is flicked off" is also immaterial. The fact remains that Li teaches the material. The device of Rooyakkers can be held by a female in unsanitary conditions and used without risk of spill. The Office never stated that male and female incontinence products are in the same field of endeavor. The office cites the relevant case law for clarity: "It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The prior art of Li is certainly reasonably pertinent to the problem sought to be solved by the claimed invention, as is Rooyakkers. Applicants' arguments with regard to the prior art of Wilson have been fully considered but are not persuasive as Applicants' arguments depend entirely on applicants' arguments regarding the rejection of independent claims 1, 26 and 34 and over Rooyakkers in view of Li, which have been addressed supra.